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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,635	11/30/2004	Allan Bernard	016325-013900US	2823
20350 7590 03/22/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER CHANDRA, GYAN	
			ART UNIT	PAPER NUMBER
			1646	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		03/22/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,635	<b>Applicant(s)</b> BERNARD ET AL.	
	<b>Examiner</b> Gyan Chandra	<b>Art Unit</b> 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 17, in part, 18, and 21 are drawn to a method of diagnosing an individual who is diabetic or prediabetic comprising detecting the level of a polypeptide with an antibody that specifically binds to the polypeptide in a sample from said individual.

Group 2, claim(s) 17, in part, 19-20, 21 are drawn to a method of diagnosing an individual who is diabetic or prediabetic comprising detecting the level of a polynucleotide encoding a polypeptide comprising quantifying mRNA encoding the polypeptide using polymerase chain reaction in a sample from said individual

The inventions listed as Groups 1-2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group 1, drawn to the special technical feature of diagnosing an individual who is diabetic or prediabetic comprising detecting the level of a polypeptide with an antibody that specifically binds to the polypeptide in a sample from said individual, which is not required by the method of Group 2.

Group 2, drawn to the special technical feature of diagnosing an individual who is diabetic or prediabetic comprising detecting the level of a polynucleotide encoding a polypeptide comprising quantifying mRNA encoding the polypeptide using polymerase chain reaction in a sample from said individual, which is not required by the method of Group 1.

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### **Further Restriction**

#### **Groups 1 and 2:**

If Group 1 or 2 is elected, a further restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

The inventions Groups 1 and 2 pertain to a number of polypeptide sequences or nucleic acids encoding a polypeptide sequence listed in claim 17 e.g., SEQ NO: 2, 4 or 6.

Each of the claimed polypeptide sequences are composed of amino acid units and are structurally distinct molecules and each polypeptide requires a special technical feature which is different of other polypeptides. Each sequence requires a unique separate search of the prior art. Searching two claimed sequences would constitute an undue burden on the examiner and the USPTO's resource because of the non-coextensive nature of these searches. Therefore, Applicant must choose 1 sequence from the group against which the search should be performed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their separate search requirements, restriction for examination purposes as indicated is proper.

**If Applicant elects group 1, a polypeptide (i.e., an amino acid sequence with SEQ ID Number) must be chosen to be considered fully responsive. If Applicant elects Groups 2, a nucleic acid encoding a polypeptide (i.e., nucleic acid encoding a amino acid sequence with SEQ ID Number) must be chosen to be considered fully responsive. It is noted that the election of a polypeptide or nucleic acid encoding a polypeptide is a Restriction/Election and not a species election.**

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

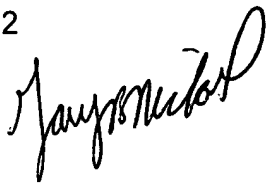
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gyan Chandra whose telephone number is (571) 272-2922. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on (571) 272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gyan Chandra, Ph.D.  
Art Unit 1646  
06 March 2007  
Fax: 571-273-2922



GARY B. NICKOL, PH.D.  
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